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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,598	06/29/2000	Jay S. Walker	00-023	1725

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary

Application No.

09/609,598

Applicant(s)

WALKER ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 and 66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's "Remarks" filed on June 25, 2003 has been considered with the following effect.

Claims 17, 36 and 66 are amended. Claim 65 is cancelled. Claims 1-64 and 66 remain pending and an action on the merits of these claims follows.

Response to Arguments

Applicant's arguments with respect to claims 1-64 and 66 have been considered but are moot in view of the new ground(s) of rejection.

Applicant remarks that Examiner clarify which interpretation Examiner is using based on interpretation of the products and services made available for bundling in Andrews to be product categories.

The Examiner notes that the interpretation of the product categories is the bundles or collections of products and/or services, see col. 2, lines 64-65.

Applicant remarks that "Andrews does not teach buyer offer information" and "receiving buyer offer information".

Examiner notes that Andrews does teach the buyer offer information and receiving buyer offer information. In col. 1, lines 52-55, Andrews discloses auction-related Internet sites, where the users are able to bid against other users for products or services with the user making the highest bid receiving the particular product and service. Furthermore in col. 13, lines 60-63, Andrews discloses bundles are auctioned

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to members of the bundle system. In an auction system, bids must be made to try to acquire the product. Such users' bids are considered the buyer's offer information.

Applicant remarks that Andrews does not teach or suggest the selecting a product or service from each available product category and "a subset of the plurality of products for each of the product categories".

Examiner draws Applicant's attention to the Office Action below.

Applicant remarks to claims 8, 17-27 and 42-46, 36, 40-41, 61-62, 47-48, 63-64, 53, and 66.

Examiner draws Applicant's attention to the Office Action below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13, 16-33, 49-52, 54-58, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No 6,285,986 Andrews et al. in view of U.S. Patent No. 5,970,469 to Scroggie et al.

Regarding claims 1-2, 28-29, 55, and 58, Andrews discloses a method and apparatus, and of facilitating comprising: receiving an indication of a plurality of product categories, each product category being associated with a plurality of products (col. 2,

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lines 59-65); and receiving buyer offer information, including of an offer amount (col. 1, lines 52-57; col. 13, lines 60-63).

However, Andrews does not disclose the selecting a subset of the plurality of products for each of the product categories; providing an indication of the selected products; and providing the receiving indication of the plurality of product categories from the buyer. Scroggie, on the other hand, teaches the selecting and the providing an indication and the receiving of the indication from the buyer, as recited in the claims (col. 9, lines 1-14; col. 9, lines 41-col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus of Andrews, to include the selecting a subset and providing an indication of the selected products and the receiving of the indication from the buyer, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28-29).

Regarding claims 3-4, 10-11, 30-33 and 56 (which depend on claim 1), Andrews discloses communication network, Internet, a web site, a telephone network, a buyer device, a personal computer, a personal digital assistant, a telephone, a controller, a merchant device, a kiosk, an interactive voice response unit, an operator, a point of sale terminal, and an automated teller machine (col. 5, line 64 – col. 6, line 59; col. 6, lines 16-19; col. 6, lines 37-59; col. 14, lines 23-29). Furthermore, Andrews discloses a single communication network and the first communication network and a second communication network (col. 1, lines 56-58; col. 5, line 64 – col. 6, line 59; col. 6, lines 16-19; col. 6, lines 37-59; col. 14, lines 23-29).

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Regarding claim 5 (which depend on claim 1), Andrews discloses a product category and a product brand associated with the product description (col. 2, lines 15-20; col. 8, lines 13-14).

Regarding claims 6-8 (which depend on claim 1), Scroggie teaches an indication of a plurality of acceptable products; the indication of the plurality of products is received from a database; and a single transaction (col. 9, lines 1-14; col. 9, lines 41-col. 10, line 4).

Regarding claim 13 (which depend on claim 1), Andrews discloses a buyer-defined offer amount (col. 1, lines 52-57; col. 13, lines 60-63).

Regarding claims 9 (which depend on claim 1), Andrews discloses receiving the buyer offer information from a buyer. (Col. 1, lines 52-57; col. 13, lines 60-63; col. 13, lines 43-47)

Regarding claims 49-52 and 54 (which depend on claim 1), Andrews discloses the payment; and arranging for the selected products to be delivered to a buyer (col. 13, lines 44-51).

Regarding claim 57 (which depend on claim 55), Andrews discloses the storage device further stores at least one of: product category database; a product database, a buyer database (Figures 4 and 5a).

Regarding claims 16-18, Andrews substantially discloses the claimed invention, however, it does not disclose the selecting a particular product for at least one of the product category; the selecting comprising at least one of: a transaction history; an address associated with the buyer; demographic information; psychographic

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information; credit rating, and another offer. Scroggie, on the other hand, teaches the selecting a particular product for at least one of the product category; selecting at least one of: a transaction history; an address associated with the buyer; demographic information; psychographic information; credit rating, and another offer; and selecting at least one of the selected products (col. 3, lines 25-31; col. 4, lines 41-45; col. 9, line 41-col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method Andrews, to include selecting, as taught by Scroggie, in order as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28-29).

Regarding claims 19-27, Andrews substantially discloses the claimed invention, however, it does not explicitly disclose subsidy. Andrews discloses the coupon, rebate or other incentives (col. 5, lines 61-63). Scroggie, on the other hand, teaches the subsidy, as recited in the claims (col. 2, lines 36-53; col. 3, lines 13-38; col. 5, lines 58-65; col. 7, line 51 – col. 8, line 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Andrews, to include the subsidy, as taught by Scroggie, in order to provide incentives to customers to shop (Scroggie col. 1, lines 10-11).

Regarding claim 66, Andrews discloses a method of facilitating a transaction comprising: providing an indication of a plurality of product categories, each product category being associated with a plurality of products (col. 2, lines 59-65); and providing

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buyer offer information, including of an offer amount (col. 1, lines 52-57; col. 13, lines 60-63).

However, Andrews does not disclose receiving an indication of selected products comprising at least one product from each of the plurality of product categories..

Scroggie, on the other hand, teaches the receiving of the indication, as recited in the claims (col. 9, lines 1-14; col. 9, lines 41-col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus of Andrews, to receiving of the indication, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28-29).

Claims 12, 14-15, 34-39, 42-48, 60, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews and Scroggie as applied to claim 1 above, and further in view of U.S. Patent No. 6,401,080 to Bigus et al.

Regarding claims 12 and 14-15, Andrews and Scroggie substantially disclose the claimed invention, however, the combination does not disclose a binding offer, a plurality of product category offer amount and a selection from a list of suggested offer amounts. Bigus, on the other hand, teaches a binding offer, , a plurality of product category offer amount and a selection from a list of suggested offer amounts (Figures 5 and 6; col.8, lines 53-58).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Andrews and Scroggie to include the offers, as taught by Bigus, in order to provide a productive, adaptive, secure

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and efficient negotiations skills for conducting commercial transactions (Bigus col. 3, lines 42-45).

Regarding claims 34-39, Andrews and Scroggie substantially disclose the claimed invention, however, the combination does not disclose the calculating a probability than offer will be accepted based on the offer amount and at least one minimum acceptable price associated with the selected products; and a minimum acceptable price. Bigus, on the other hand, teaches the calculating and the minimum acceptable price, as recited in the claims (see at least col. 4, lines 24-51).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Andrews and Scroggie to include the calculating and the minimum acceptable price, as taught by Bigus, in order to provide a productive, adaptive, secure and efficient negotiations skills for conducting commercial transactions (Bigus col. 3, lines 42-45).

Regarding claims 47-48, Andrews and Scroggie substantially disclose the claimed invention, however, the combination does not disclose the offer is not acceptable and providing a suggested modification offer. Bigus, on the other hand, teaches the suggested modification and the offer is not acceptable (see at least col. 4, lines 24-51).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Andrews and Scroggie to include the suggested modification and the offer is not acceptable, as taught by Bigus,

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in order to provide a productive, adaptive, secure and efficient negotiations skills for conducting commercial transactions (Bigus col. 3, lines 42-45).

Regarding claims 42-46, Scroggie discloses the subsidy (col. 2, lines 36-53; col. 3, lines 13-38; col. 5, lines 58-65; col. 7, line 51 – col. 8, line 9).

Regarding claims 60, Andrews discloses a method and apparatus, and of facilitating comprising: receiving an indication of a plurality of product categories, each product category being associated with a plurality of products (col. 2, lines 59-65); and receiving buyer offer information, including of an offer amount (col. 1, lines 52-57; col. 13, lines 60-63).

However, Andrews does not disclose the selecting a subset of the plurality of products for each of the product categories. Scroggie, on the other hand, teaches the selecting, as recited in the claims (col. 9, lines 1-14; col. 9, lines 41-col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and apparatus of Andrews, to include the selecting a subset, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28-29).

Andrews and Scroggie do not disclose the evaluating the offer. Bigus, on the other hand, teaches the evaluating the offer (col. 4, lines 24-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Andrews and Scroggie to include the evaluating the offer, as taught by Bigus, in order to provide a productive, adaptive, secure and efficient negotiations skills for conducting commercial transactions (Bigus col. 3, lines 42-45).

Regarding claims 63-64 (which depend on claim 60), Bigus teaches the suggested modification and the offer is not acceptable (see at least col. 4, lines 24-51).

Claims 40-41 and 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews, Scroggie and Bigus as applied to claim 34 above, and further in view of U.S. Patent No. 5,905,975 to Ausubel. Andrews, Scroggie, (and Bigus substantially disclose the claimed invention, however, the combination does not disclose the penalty. Ausubel, on the other hand, teaches the penalty (col. 30, lines 11-12; col. 30, lines 16-18). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the penalty, as taught by Ausubel, in order to avoid the withdrawing of bids (Ausubel col. 30 lines 16-18).

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews and Scroggie as applied to claim 1 above, and further in view of U.S. Patent No. 5,890,136 to Kipp. Andrews and Scroggie substantially disclose the claimed invention, however, the combination does not disclose the transmitting information enabling a buyer to take possession of the selected products at a merchant. Kipp, on the other hand, teaches the transmitting information enabling a buyer to take possession of the selected products at a merchant (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the taking possession of the selected products at a merchant, in order to pickup the article (Kipp col. 2, lines 24-25).

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Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andrews in view of Scroggie in further view of Bigus and in further view of Kipp.

Andrews discloses the payment identifier, a buyer offer, arranging for the buyer to provide payment (see at least abstract, summary). However, Andrews does not disclose an indication of a first and second product category; the binding offer; the selecting of a first and second product; evaluating the offer; providing to the buyer an indication of the first and second product; and the transmitting information enabling the buyer to take possession of the products at a merchant. Scroggie, on the other hand, teaches an indication of a first and second product category; the selecting of a first and second product, providing to the buyer an indication of the first and second product (see at least abstract, summary, col. 9, lines 1-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Andrews, to include the indication and the selecting and providing an indication, as taught by Scroggie, in order to automatically sell and promote groups of products and services (Andrews col. 1, lines 28-29).

Andrews and Scroggie do not disclose the binding offer and the evaluating the offer and the transmitting information enabling the buyer to take possession of the products at a merchant. Bigus, on the other hand, teaches the binding offer and evaluating the offer (col. 4, lines 24-51).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Andrews and Scroggie to include the binding offers and evaluating the offer, as taught by Bigus, in order to

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provide a productive, adaptive, secure and efficient negotiations skills for conducting commercial transactions (Bigus col. 3, lines 42-45).

Andrews, Scroggie and Bigus do not disclose the transmitting information enabling the buyer to take possession of the products at a merchant. Kipp, on the other hand, teaches the transmitting information enabling the buyer to take possession of the products at a merchant (abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the transmitting information enabling the buyer to take possession of the products at a merchant (Kipp col. 2, lines 24-25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Mtot
September 8, 2003


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